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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,517	09/08/2003	John M. Albrecht	4134-PA2C	9164

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06/15/2004

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EXAMINER

NGUYEN, KIM T

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,517

Applicant(s)

ALBRECHT, JOHN M.

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 1, 6, 13, and 16 are objected to because of the following informalities:
 - a) In claim 1, line 2; claim 6, line 2; claim 13, lines 3-4, the claimed limitation "first memory" should be corrected to "a first memory".
 - b) In claim 1, line 6; claim 13, line 8, the claimed limitation "second memory" should be corrected to "a second memory".
 - c) In claim 6, lines 6-7; and claim 16, line 8, the claimed limitation "password-accessible memory" should be corrected to "a password-accessible memory".
 - d) In claim 13, line 4; and claim 16, line 4, the claimed limitation "electronic apparatus" should be corrected to "an electronic apparatus".
 - e) In claim 16, line 3, the claimed limitation "memory" should be corrected to "a memory".
- Appropriate correction is required.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 6-12 and 16-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,616,532. This is a double patenting rejection.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5 and 13-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,616,532.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 and 13-15 disclose the same subject matter taught in claims 1-4 of patent '532 in broader scope by eliminating the limitation allowing access to an electronic component based on the password.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaur et al (US patent No. 6,196,920).

a. As per claim 1, Spaur discloses an electronic game enhancement system comprising an electronic game stored in a first memory (col. 16, lines 53-58); electronic apparatus having an input device (col. 3, lines 1-10; and col. 6, lines 27-38); an electronic component stored in a second memory for enhancing (adding advertisement) the electronic game (col. 4, lines 35-36; col. 15, lines 65-67; and col. 16, lines 1-22); a consumer instrument (ad server) (col. 9, lines 65-67; and col. 7, lines 1-3). Spaur does not explicitly disclose a data transfer system for transferring the electronic component from the second memory to the first memory. However, Spaur discloses a communication network 40 (Fig. 1) for transmitting data between the electronic apparatus and the sub-systems (col. 6, lines 47-63; and col. 15, lines 30-31). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the communication network 40 as a data transfer system and to associate the communication network to the electronic apparatus and the sub-devices in order to facilitate downloading or uploading data between systems.

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b. As per claim 2-3, Spaur discloses an advertisement consumer instrument (col. 4, lines 35-36 and col. 2, lines 24-26). Further, since Spaur discloses an advertisement for advertising a consumer product or a service, Spaur obviously discloses including a consumer product in the advertising consumer instrument. Moreover, attaching a bonus device (product) to a consumer product in advertise message would have been well known to a person of ordinary skill in the art at the time the invention was made.

c. As per claim 4-5, Spaur discloses using a computer as the electronic apparatus (col. 3, lines 1-3). Further, using a personal game device in place of the computer as the electronic apparatus would have been both well known and obvious design choice.

d. As per claim 13-15, refer to discussion in claims 1-2 above. Further, permitting access to a service after payment of the service would have been well known to a person of ordinary skill in the art at the time the invention was made.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

kn

Date: June 12, 2004



KIM NGUYEN
PRIMARY EXAMINER